

REMARKS

Applicant respectfully requests reconsideration and allowance of the subject application. Claims 20 and 25 have been amended. Claim 25 has been rewritten in independent form. Claim 24 has been cancelled. Claims 1-23 and
5 25 are pending.

35 U.S.C. §112

Claims 5, 6 and 8 were rejected as indefinite under 35 U.S.C. §112, second paragraph. The Office asserted that “the claims are written in passive
10 state which is vague and indefinite for a method claim”. *Office Action Dated December 10, 2004*. The Applicant respectfully disagrees.

The Applicant is not aware of authority for a passive/active voice distinction under 35 U.S.C. § 112 asserted by the Office. The claims as written particularly point and distinctly claim the subject matter. The MPEP describes
15 the approach that should be taken by the Office when considering 35 U.S.C. § 112, second paragraph, a portion of which is excerpted as follows:

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph, is whether the claim meets
20 the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. When the examiner is satisfied that patentable subject matter is disclosed, and it is apparent to the examiner that the claims are directed to such
25 patentable subject matter, he or she should allow claims which define the patentable subject matter with a reasonable degree of particularity and distinctness. Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire. Examiners
30 are encouraged to suggest claim language to applicants to improve the clarity or precision of the language used, but should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy

the statutory requirement. . . [I]f the language used by applicant satisfies the statutory requirements of 35 U.S.C. 112, second paragraph, but the examiner merely wants the applicant to improve the clarity or precision of the language used, the claim must not be rejected under 35 U.S.C. 112, second paragraph, rather, the examiner should suggest improved language to the applicant. *See MPEP § 2173.02.*

Dependent Claims 5 and 6 both depend from claim 4 and describe the source of the previously stored database information. Claim 8 recites “associating rules to be followed when printing device data associated with a customer meets certain criteria”. Therefore, each of these claims meet the threshold of clarity and precision required by 35 U.S.C. § 112. Accordingly, Applicant respectfully requests withdrawal of the §112 rejection.

35 U.S.C. §102

Claims 20-23 were rejected under 35 U.S.C. §102(e) as being anticipated by published U.S. Patent Application US2002/0075145 to Hardman et al. (hereinafter, “Hardman”) or in the alternative as obvious in light of Hardman. Applicant respectfully traverses the rejection.

Claim 20 has been amended. As amended, Claim 20 recites “the product is a printing device that utilizes a replaceable component with component memory” and “the information contained in the product usage field is obtained by retrieving printing device usage data stored in the component memory”. Hardman does not disclose, suggest or teach these features.

Hardman “relates in general to tire parameter monitoring systems and in particular to an electronic tire management system including tire tags, where each tag has an electronic sensor circuit that conserves power by ‘sleeping’ and periodically ‘waking-up’ to measure and store tire parameters, such as temperature and pressure”. *Hardman, Paragraph [0002]*. Hardman merely

describes a system for retrieving tire parameter data from tires. Hardman is not drawn to and does not suggest any application outside of monitoring tires. Nowhere in Hardman is there disclosure, teaching or suggestion of “printing device usage data”, “printer device” or “printing device that utilizes a replaceable component with component memory” as recited in Claim 20. Indeed, Hardman does not even describe any other use besides tire monitoring. Further, this contention is supported by the Office in discussing other claims in the application. For instance, the Office concedes that Hardman does not disclose “the type of device, i.e. printing device.” *Office Action Dated December 10, 2004, Page 5*. For at least these reasons, Claim 20 is allowable over Hardman. Applicant respectfully requests that the §102 rejection of Claim 20 be withdrawn.

Claims 21-23 depend from Claim 20 and are allowable for at least the same reasons as stated with respect to Claim 20. These claims are also allowable for their own recited features, which are not disclosed, taught or suggested by the submitted references, alone or in combination. Accordingly, Applicant respectfully requests that the §102 rejection of Claims 21-23 be withdrawn.

35 U.S.C. §103

Claim 1-9, 10-15, 16-19 and 24-25 are rejected under 35 U.S.C. §103 as being unpatentable over Hardman in view the Applicant’s own disclosure (hereinafter “Disclosure”). The Applicant respectfully traverses the rejection.

First, it is respectfully submitted that Hardman is nonanalogous art in relation to the recited features of Claims 1-9, 10-15, 16-19 and 24-25. As the Examiner is well aware, “[i]n order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of

applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See MPEP 2141.01.

5 The Applicant respectfully asserts that Hardman is nonanalogous art and may not be relied upon in the rejection of the above referenced claims. Hardman is drawn exclusively towards a tire monitoring system. For example, Hardman recites that the “present invention relates in general to tire parameter monitoring systems and in particular to an electronic tire management system including tire tags,” *See Hardman, Page 1, Paragraph [002]*. Hardman
10 therefore limits its own scope to tire monitoring. Hardman repeatedly refers to “tire tags”, “tire data”, and defines the system as “Electronic Tire tag Management System (ETMS)” and does not disclose any other contemplated use. *See Hardman*. Hardman merely describes a system for retrieving tire parameter data from tires. Hardman is not drawn to and does not suggest any
15 application outside of monitoring tires.

The subject Application, however, relates generally to managing data collected from printing devices and more particularly to retrieving data from printing device components that have memory and utilizing the printing device data to provide improved customer service. Nowhere in Hardman is there
20 disclosure, teaching or suggestion of printing devices, printers, printer data, or the like. Hardman does not describe any other use besides tire monitoring. Therefore, an artisan in the Applicant’s field of endeavor seeking to manage data collected from printing device simply would not turn to a tire monitoring system as described in Hardman. Accordingly, Hardman is non-analogous
25 prior art.

In addition to reliance on nonanalogous art, it is respectfully submitted that the combination of references suggested by the Office here in rejecting the

above referenced claims is defective. When applying 35 U.S.C. § 103, the following tenets of patent law must be adhered to: (A) the claimed invention must be considered as a whole; (B) the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and (D) reasonable expectation of success is the standard with which obviousness is determined. *See MPEP § 2141* and *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 220 USPQ 182, 187 n.5 (Fed. Cir. 1986). The features of Claims 1-9, 10-15, 16-19 and 24-25 are not disclosed, taught or suggested by the cited art, alone or in combination. Additionally, the portion of the Disclosure referenced by the Office does not contain admitted prior art. Further, the Examiner has engaged in impermissible hindsight reconstruction. Further discussion of these arguments may found in relation to the following claims.

Claim 1 recites a method that includes “retrieving printing device data from component memory of a replaceable component from a printing device used by a customer; storing the printing device data in a customer database”. As previously described in relation to Claim 20, Hardman does not teach or suggest “printing device data”, “component memory” integrated with a “replaceable printer component”, or “printing device data is retrieved from the component memory and stored in the customer database” as recited in Claim 1.

To correct the defects of Hardman, the Office relies solely upon the Disclosure, as described in the following excerpt:

Background discloses a printing device with well know issue of replacing replaceable component, i.e. toner cartridge, and problems of lacking information or database monitoring printing device information for the customer service operator to review automatically when problems

arise and relying on the skills of the customer service operator. *Office Action Dated December 10, 2004, Page 5.*

5 The Disclosure however does not disclose and the Office does not cite any reference that discloses “retrieving printing device data from component memory of a replaceable component from a printing device” as recited in Claim 1. Neither Hardman nor the Disclosure alone or in combination disclose, teach or suggest the claimed features.

10 The Office has relied solely upon the Disclosure to supply the motivation or suggestion to modify Hardman. For instance, the Office asserts the following:

15 Background discloses a printing device with well know issue of replacing replaceable component, i.e. toner cartridge, and problems of lacking information or database monitoring printing device information for the customer service operator to review automatically when problems arise and relying on the skills of the customer service operator. The information about the customer is limited on a registration card which would require manually
20 searching and finding the item. *Office Action Dated December 10, 2004, Page 5.*

Using the statement of the problem identified in the Disclosure as prior art against the claims is not proper. The MPEP discusses what are to be deemed “admissions” by applicants as follows:

25 A statement by an applicant during prosecution identifying the work of another as “prior art” is an admission that that work is available as prior art against the claims, regardless of whether the admitted prior art would otherwise qualify as prior art under the statutory categories of 35 U.S.C.
30 102. *Riverwood Int’l Corp. v. R.A. Jones & Co.*, 324 F.3d 1346, 1354, 66 USPQ2d 1331, 1337 (Fed Cir. 2003). *MPEP 2129.*

Here, the Office is using the Applicant’s own work product, the identification and statement of the problem to be addressed, as the motivation to modify the

references. The Disclosure describes problems identified by the Applicant in accordance with the requirements of the MPEP, “the problems involved in the prior art or other information disclosed which are solved by the applicant’s invention should be indicated.” *M.P.E.P. §608.01(c)*. The Applicant does not
5 in any way admit that a reference is prior art, but rather describes one of the many deficiencies in the prior art that are addressed by the Application. Further, these deficiencies are not disclosed, taught or suggested anywhere in Hardman, which further supports the previous argument that Hardman is nonanalogous. Yet Further, the Office concedes that Hardman does not
10 disclose “the type of device, i.e. printing device.” *Office Action Dated December 10, 2004, Page 5*. Thus, it is respectfully submitted that the Disclosure does not qualify as admitted prior art and respectfully requests that the Office submit a reference in support of the modification or withdraw the rejection.

15 The Applicant also respectfully submits that the Office has not provided the required teaching or suggestion from the prior art to make the claimed combination, and rather has engaged in impermissible hindsight reconstruction. As previously described, Hardman is drawn exclusively towards a tire monitoring system. Hardman recites that the “present invention relates in
20 general to tire parameter monitoring systems and in particular to an electronic tire management system including tire tags,” *See Hardman, Page 1, Paragraph [002]*. Hardman therefore limits its own scope to tire monitoring. Hardman repeatedly refers to “tire tags”, “tire data”, and defines the system as “Electronic Tire tag Management System (ETMS)” and does not disclose any
25 other contemplated use. *See Hardman*. Accordingly, Claim 1 is allowable and withdrawal of the rejection is respectfully requested.

Additionally, in regards to dependent Claims 2-9, the Applicant strongly disagrees with the assertion by the Office that the recited features of Applicant's invention are "non-essential to the claimed invention". *Office Action Dated December 10, 2004, Pages 6-7*. The Applicant's invention in the
5 case of each claim includes everything which is recited in the claim. Contrary to the Examiner's assertion, the recited features further define the claimed invention and are essential. Recited features may not simply be dismissed as non-essential to the claimed invention. Rather, "The prior art reference (or references when combined) must teach or suggest all the claim limitations".
10 *See MPEP 2143*. In addition, the Applicant strongly disagrees with the "fairly taught" standard repeatedly asserted by the Examiner. *See e.g., Office Action Dated December 10, 2004, Page 6-7*. To the extent that "fairly taught" as asserted by the Examiner deviates from the statutory requirements for patentability the standard is erroneous.

15 Further, as the Examiner is aware, the Examiner "ordinarily should reject each claim on all valid grounds available." *M.P.E.P. §707.07(g)* Further, "[w]here a major technical rejection is proper, it should be stated with a full development of reasons rather than by a mere conclusion coupled with some stereotyped expression." *Id.* The Examiner's action should be complete as to
20 all matters. *37 C.F.R. 1.104* and *M.P.E.P. §707.07(a)*. Failure to provide a full development of the reasons removes any opportunity for the Applicant to rebut any reasoning used by the Examiner in making the rejections. Therefore, full development of the reasons or withdrawal of the rejection is requested.

Claim 2 recites "the printing device data further comprises information
25 that uniquely identifies the printing device". **Claim 3** recites "the printing device data further comprises information regarding usage of the printing device". Hardman does not teach or suggest information that uniquely

identifies the printing device as recited in Claim 2. Additionally, Hardman does not teach or suggest information regarding usage of the printing device as recited in claim 3. Hardman does not discuss information about the printer or usage. Rather, the portions of Hardman relied upon by the Examiner merely
5 describe the outputting of tire parameter data locally or remotely, tire and tire tag serial numbers, tire tag features, and the editing of vehicle and tire data on a tire tag. *See Hardman Paragraphs [0119],[0145],[0149],[0265] and [0309]*. Hardman is narrowly drawn to tire parameter monitoring. Indeed, Hardman includes a very extensive “Field of the Invention” section that is limited
10 exclusively to tire monitoring. Hardman does not discuss printer device data, or printer information at all.

Claim 4 recites “wherein the accessing the printing device data in the customer database further comprises accessing previously stored database information related to the customer”. **Claim 5** recites “wherein the previously
15 stored database information is derived from memory of previously returned components”. The Examiner relies upon portions of Hardman that describe only “tire history data” downloaded or transferred **from a tire tag**. *See Hardman, Paragraphs [0151], [0152], and [0169]*. Hardman fails to disclose “accessing the printing device data in the customer database” or “accessing
20 previously stored database information related to the customer” as recited in claim 4. Additionally, Hardman fails to disclose accessing previously stored database information “from the memory of previously returned components” as recited in claim 5. Further, Hardman fails to teach or suggest “previously returned components” at all. Thus, Hardman fails to teach or suggest all the
25 claim features of claims 4-5.

Claim 6 recites “wherein the previously stored database information is derived from information submitted by the customer on a registration card”.

Examiner relies upon portions of Hardman that fail to disclose “information submitted upon a registration card” as recited in Claim 6. *See Hardman Paragraph, [0145] and [0152]*. Hardman does not mention a registration card, and thus fails to teach or suggest all the claimed features of claim 6.

5 **Claim 7** recites “wherein the printing device is a laser printer and the replaceable component is a toner cartridge”. The Examiner asserts the type of printer or replaceable component “is non-essential to the claimed invention, and would have been obvious to a skilled artisan since the selection of any well know conventional would have been obvious” *Office Action Date December*
10 *10, 2004, Page 6*. It is not clear what is meant by this assertion which the Applicant assumes is not complete. As previously described, the Applicant objects to the statement that the recited features are nonessential. The Examiner is respectfully requested to cite any statutory authority which permits the Examiner to ignore the claimed features rather than fully develop the
15 reasoning behind the rejection. Again, the Examiner does not cite any part of Hardman that discloses “printing device”, “laser printer” or “toner cartridge” as recited in claim 7, and thus fails to teach or suggest all the claimed features of Claim 7.

Claim 8 recites “further comprising associating rules to be followed
20 when printing device data associated with a customer meets certain criteria”. Examiner relies upon a portion of Hardman which describes calculating Cold Fill Inflation Pressure and comparing to a specified target. *See Hardman Paragraph [0224]*. Hardman, however, fails to disclose “associating rules to be followed when printing device data associated with a customer meets certain
25 criteria” as recited in Claim 8. Thus, Hardman fails to teach or suggest all the claimed features of Claim 8.

Claim 9 recites a method comprising in part “testing the replaceable component for a defect”, “storing defect information in the customer database”, “associating the defect information to one or more other customers referred to in the customer database that use a similar replaceable component” and
5 “wherein the accessing the printing device data further comprises accessing the defect information in the customer database”. The Examiner relies upon a portion of Hardman which describes using actual tire parameter data from a tire tag to determine which tires “are in need of service, such as being under-inflated” such that they “can be attended to immediately” while “other tires
10 that require no service can then be given no attention other than a routine visual inspection”. See *Hardman Paragraphs [0234]- [0235]*. Hardman describes using tire tag data to determine which tires should be serviced. Hardman does not teach or suggest the above recited features of Claim 9. Hardman fails to teach or suggest “testing for the replaceable component for a defect”, “storing
15 defect information”, “associating defect information to one or more other customers”, or “accessing the defect information” as recited in claim 9. Indeed, Hardman does not describe defect testing or storing/accessing defect information at all, and thus fails to teach or suggest all the claimed features of Claim 9.

20 Additionally, Claims 2-9 depend directly or indirectly from Claim 1 and are allowable for at least the same reasons as stated with respect to Claim 1. These claims are also allowable for their own recited features as discussed previously, which are not disclosed, taught or suggested by the submitted references, alone or in combination. Accordingly, for these and other reasons,
25 the Applicant respectfully requests that the §103 rejection of Claims 2-9 be withdrawn.

Claim 10 recites a system that includes “printing device replaceable component including component memory integrated therewith”, “a customer database that stores customer information for multiple customers, including printing devices and printing device replaceable components used by the customers” and “printing device data is retrieved from the component memory and stored in the customer database”. **Claim 16** recites a method that includes “printing devices that use replaceable components with integrated component memory” and “compiling data retrieved from the component memory of a plurality of replaceable components into a customer database”. **Claim 25** has been rewritten in independent form and recites a database which includes “the product is a printing device replaceable component with component memory” and “the information contained in the product usage field is obtained by retrieving printing device usage data stored in the component memory, the printing device usage data being stored in the component memory while the replaceable component was installed in the printing device”. Neither Hardman nor the Disclosure, alone or in combination, disclose, teach or suggest these aspects.

As previously described with respect to Claim 20, Hardman does not disclose, teach or suggest a “printing device” or “component memory” as recited in Claims 10, 16 and 25. The combination of Hardman with the Disclosure does not teach or suggest the claimed features. Further, for reasons previously recited with respect to Claim 1, the Office’s rejection of Claim 10 depends upon hindsight knowledge of the Applicant’s invention which is impermissible. Accordingly, the Applicant respectfully requests that the §103 rejection of Claims 10, 16 and 25 be withdrawn.

Claims 11-15 depend directly or indirectly from Claim 10 and are allowable for at least the same reasons as stated with respect to Claim 10.

These claims are also allowable for their own recited features, which are not disclosed, taught or suggest by the submitted references, alone or in combination. The discussion above with respect to claims 2-9 is pertinent to claims 11-15 as well. Therefore, the Applicant will not further burden the
5 record by repeating the above remarks. Accordingly, Hardman fails to teach or suggest the recited features of claims 11-15 for the corresponding reasons set forth above with respect to claims 2-9. For at least these reasons, Applicant respectfully requests that the §103 rejection of claims 11-15 be withdrawn.

Claims 17-19 depend directly or indirectly from Claim 16 and are
10 allowable for at least the same reasons as stated with respect to Claim 16. These claims are also allowable for their own recited features, which are not disclosed, taught or suggest by the submitted references, alone or in combination.

Specifically, Claim 17 recites “storing customer information for a
15 customer in the customer database and associating the customer information with compiled data that is related to a printing device used by the customer”. Hardman fails to teach or suggest “associating the customer information with compiled data that is related to a printing device used by the customer” as recited in Claim 17. Claim 18 recites “acquiring the customer information for
20 the customer from a registration card used to register the customer as the purchaser of the printing device used by the customer”. Claim 18 is rejected for the same reason as set forth for Claim 6. As with Claim 6 discussed above, Hardman fails to disclose “a registration card” as recited in claim 18. Claim 19 recites “associating the customer information with general data related to a
25 printing device or printing device replaceable component used by a customer”. As discussed previously, Hardman deals with tires and not printer devices. Hardman does not teach or suggest “printing device” or “printing device

replaceable component” as recited in claim 19. For at least the above reasons, Applicant respectfully requests that the §103 rejection of claims 17-19 be withdrawn.

Finally, the Applicant strongly disagrees with the Examiner’s assertion that Hardman’s self-serving boilerplate about the scope of the claims and equivalents thereof renders Applicant’s invention obvious. For example, the Examiner asserts the following:

Note on [309] and [313], Hardman et al discloses that any other desired device or parameters can be implemented and that other element, steps, methods and techniques that are insubstantially different form those described herein are also within the scope of the invention. Thus the scope of the invention should not be limited by the particular embodiments described herein but should be defined by the appended claims and equivalents thereof. Changing to other type of device or component would be considered as selecting other equivalent device and component and would have been obvious, absent evidence of unexpected results. *Office Action Dated, December 10, 2004, Page 10.*

Applicant respectfully disagrees that the scope of the invention in Hardman is expanded by the described boilerplate language. This type of language does not expand the scope of Hardman beyond the described limited scope of tire tags. As previously stated, when applying 35 U.S.C. § 103, “the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination” and “must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention”. *See MPEP § 2141 and Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 220 USPQ 182, 187 n.5 (Fed. Cir. 1986). Nowhere in the asserted boilerplate is the desirability of the modification suggested without engaging in impermissible hindsight vision afforded by the claims of the subject Application.


Further, [313] states "it will be obvious to those skilled in the art that changes and modifications of the present invention, in its various embodiments, may be made **without departing from the spirit and scope of the invention.**" The spirit and scope of Hardman is clearly limited to tire tags and tire parameter monitoring. This language is clearly limiting and should not serve to broaden the scope of Hardman, and most certainly cannot be used as a basis for rendering the Applicant's invention obvious.

Conclusion

For at least the above reasons, all pending claims 1-23 and 25 are in condition for allowance. Applicant respectfully requests reconsideration and prompt issuance of the subject application. If any issues remain that prevent issuance of this application, the Examiner is urged to contact the undersigned attorney before issuing a subsequent Action.

Respectfully submitted,

Dated: 3/19/05

By: 
William J. Breen III
Reg. No. 45,313
(509) 324-9256 ext. 249